



Best practices in the PCT international phase

Session 1

Preparing to file (1)

■ Decision-making process

- Leave enough time before end of priority period
- Have a clear decision-making structure in place
- Paris or PCT?
- Avoid last-day and even more so last-minute filings

■ State-of-the-art docketing system in place

- Two independent systems
- Second pair of eyes review

■ Review need for any foreign filing licenses

Preparing to file (2)

■ Choice of RO?

- What choices are available?
- Reasons not to use your home Office
- Advantages/disadvantages in using RO/IB
- Right to file with RO of choice

■ Know your RO

- filing methods available
- payment methods
- closing dates
- languages accepted

Preparing to file (3)

■ Choice of ISA?

- Whether and what choices you have depends on RO
- What choices would you have if you use RO/IB?
- If you have a choice, which factors to consider?
 - Search fee amount
 - Timeliness
 - Effect on national/regional phase
 - Quality of reports
 - PCT-PPH benefits
 - Excluded subject matter
 - Languages searched
 - National phase fee reductions

Preparing to file (4)

- Right to file

- Assignments need to have been made before filing

- Right to claim priority at the international filing date

- Assignments need to have been made before filing

- Accession number for deposited biological material

Preparing to file (5)

- Choice of filing method: electronic beats paper
 - ❑ Ensure that your filing software is fully up-to-date (or use ePCT filing or similar web-based systems if you can...)
 - ❑ Give all your electronic files clear and distinctive names
 - ❑ Double-check that the correct files have been attached
 - ❑ Check for possible conversion errors
 - ❑ Always submit pre-converted files if accepted by RO
 - ❑ Electronic signature requirements

Preparing to file (6)

■ Preparing the request form:

□ Naming of the applicants:

- Impact of US AIA
- Always include one applicant who has the right to file an international application
- Check correct spelling of names
- Addresses of inventor/applicants

□ Representation: agent, common representative or address for correspondence?

□ Exclusion of certain designations? Special situation of DE, JP or KR

Preparing to file (7)

- Preparing the request form (cont.):
 - Correctly indicate all priority claims
 - Correctly indicate your sequence listing in check list
 - Ideally, only file one copy of a sequence listing and in txt.format
 - Make use of PCT declarations
- If you are about to miss the priority period
 - Always have a plan B ready
 - Ways to extend the priority period
 - Request restoration of the priority right

After filing (1)

- Once filed, view what you have submitted, on the date of submission, through electronic file access systems, if available
- If a mistake as been made:
 - Same day corrections
 - Incorporation by reference
 - Not a perfect solution
 - Diverging practices of Offices

After filing (2)

- Monitor receipt of Forms PCT/RO/105 and PCT/IB/301
- Priority documents
 - Best way: ask RO to prepare and transmit in request form
 - If not possible, use DAS
 - If not possible: order paper document

PCT Resources/Information

For general questions about the PCT, contact the PCT Information Service at:

Telephone: (+41-22) 338 83 38

Facsimile: (+41-22) 338 83 39

E-mail: pct.infoline@wipo.int

matthias.reischle@wipo.int +41-22-338 9627